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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,228	07/19/2001	Lawrence G. Almeda	LGA 0102 PUS	9723

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Lawrence G. Almeda
2501 S. Christian Hills Drive
Rochester Hills, MI 48309

EXAMINER

EDELMAN, BRADLEY E

ART UNIT PAPER NUMBER

2153

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,228

Applicant(s)

ALMEDA ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's request for reconsideration filed on January 3, 2005. Claims 1-7 and 9-11 are presented for further examination. Note: Because of the new grounds for rejection, this Office action is non-final.

Drawings

1. The drawings are objected to because Figures 1 and 4 fail to include adequate labels or an adequate legend. These figures only contain boxes, lines, cloud shapes, and numbers. However, 37 CFR § 1.83(a) states that such drawings should be labeled. Thus, Applicant should include adequate labels or a legend in figures 1 and 4 to comply with 37 CFR § 1.83(a). For example, box 12 should be labeled "first system" as described in the specification, box 13 should be labeled "client" or "first client," etc.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-7, and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei (U.S. Patent No. 6,654,779).

In considering claim 1, Tsuei discloses a method of managing an update of a changed email address of a first client of a first system, the update being managed by the first system, the method comprising:

providing an old email address and a new email address of the first client (i.e. recipient), and providing an email historical database associated with the first system in which information of the old and new email addresses are stored, the email historical database being in communication with the first system via a communication network

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(col. 12, lines 19-21, "the EAMS 330 creates a record in its database 338 containing the old e-mail address in association with the new e-mail address");

sensing a subsequent email address of a subsequent email message to be sent from a second client (i.e. sender) of the first system (col. 9, lines 4-6, "a sender composes a message at his or her computer and addresses it to the address believed to be correct for an intended recipient");

searching in the email historical database to determine whether the subsequent email address is the old email address of the first client (col. 9, lines 60-63, "EAMS 330 searches its database [to] see if it contains a record relating to a new address to the address contained in the address query"); and

redirecting the subsequent email message to the new email address of the first client, if the subsequent email address is determined to be the old email address of the first client (col. 10, lines 25-37, "if there is an EAMS match for the address... the message is then delivered to the intended recipient [using the new address]).

In considering claim 2, Tsuei further discloses inputting the old email address and the new email address into the email historical database associated with the first system (col. 12, lines 19-21, "the EAMS 330 creates a record in its database 338 containing the old e-mail address in association with the new e-mail address").

In considering claim 3, Tsuei further discloses that inputting the old and new email addresses is performed during a period of the first client's subscription with the

first system (col. 10, lines 38-41, "registration process 500 in which persons with e-mail addresses or mailboxes ('consumers') provide information to the disclosed EAMS 330 for the purpose of maintaining the cross reference table or database").

In considering claim 5, Tsuei further discloses determining whether the subsequent email address is the old email address of the first client (col. 9, lines 60-64, wherein the database search does this).

In considering claim 6, Tsuei further discloses confirming with the second client that the subsequent email address is the old email address (col. 10, lines 30-31, "notifies the sender via e-mail of the intended recipient's new address," wherein such notification necessarily informs the sender that the subsequent address is an old email address).

In considering claim 7, Tsuei further discloses that the information includes data indicative of the first client (col. 12, lines 19-27, wherein the information includes a consumer authenticator in addition to other information indicative of the first client).

In considering claim 10, Tsuei further discloses that the first system includes a system of an Internet carrier ("ISP"), a system of hard-drive for a central processing unit (inherent in a server), and a local area network, metropolitan area network, and wide area network (all inherently part of the Internet).

In considering claim 11, Tsuei further discloses that the communication network includes a local area network, a metropolitan area network, a wide area network, the Internet, and an Intranet (these are all inherent parts of the Internet).

Claim Rejections - 35 USC § 103

3. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, in view of Sommerer (U.S. Patent No. 6,694,353).

In considering claim 9, although the system taught by Tsuei discloses substantial features of the claimed invention, it does not disclose requesting authorization from the second client to redirect the subsequent email message to the new email address, and receiving authorization from the second client to redirect the subsequent message to the new email address. Nonetheless, this features is well known in systems that redirect email messages from an old email address to a new email address, as evidenced by Sommerer (see col. 4, lines 42-48, "attempting to direct a message to an expired address results in a notification to the user that the address is considered expired and that a newer address is known. The user is provided with an option of replacing the entered destination with the newer address"). Given this knowledge, it would have been obvious to a person having ordinary skill in the art to have the Tsuei system ask the email sender for authorization to redirect the message to the new email address, just in case the user does not want to or is not permitted to send messages to particular e-mail addresses.

In considering claim 4, this claim contains similar limitations as those already discussed with regard to claim 9, and thus would have been obvious for the same reasons. Notably, Sommerer discloses determining if an email is undeliverable to a certain address, notifying a sending client that the email is undeliverable, requesting an authorization from the sending client to replace the address with a new address, and receiving authorization to replace the address (col. 4, lines 42-48). Tsuei further discloses searching an email database to determine whether the subsequent email address is the old email address of the first client (col. 9, lines 60-63, "EAMS 330 searches its database [to] see if it contains a record relating to a new address to the address contained in the address query"). Thus, it would have been obvious to a person having ordinary skill in the art to include the authorization steps taught by Sommerer before performing the searching steps taught by Tsuei, because a sender may not want to send any messages to certain e-mail domains or addresses (i.e. if they don't use encryption, etc.) and thus should have the choice before the sender's message is redirected.

Response to Arguments

In response to Applicant's request for reconsideration filed on January 3, 2005, the following remarks are noted:

- a. Applicant does not understand Examiner's grounds for objecting to the drawings.
- b. Tsuei clearly does not teach sensing the subsequent email address prior to the message being sent as recited in claim 1.

c. Tsuei does not teach that the historical database is “in communication with the first system via a communication network,” as recited by claim 1.

d. Tsuei does not teach or suggest each and every element as recited in claim 4, and therefore does not provide motivation for requesting authorization to determine if the subsequent address is the old email address of the first client.

In considering (a), Applicant does not understand Examiner’s grounds for objecting to the drawings. The objection in the original Office action stated “the drawings are objected to because Figures 1 and 4 fail to include adequate labels or an adequate legend.” This is the Examiner’s grounds for objecting to the drawings. Labels should be included in the drawings according to 37 CFR § 1.83(a) (“conventional features... should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (i.e. a labeled rectangular box)”). Because Figures 1 and 4 only show boxes, lines, clouds, and numbers, it does not comply with 37 CFR § 1.83(a).

In considering (b), Applicant contends that Tsuei clearly does not teach sensing the subsequent email address prior to the message being sent as recited in claim 1. Examiner respectfully disagrees. First, note that the claim does not use the word “prior” or “before” and thus does not include any temporal limitations such as sensing *prior* to sending a message. The claim limitation instead reads “sensing a subsequent email address of a subsequent email message to be sent from a second client of the first system.” Nonetheless, even if the claim had included such a temporal limitation, the

feature of sensing an email address is taught by Tsuei. Tsuei discloses that "a sender composes a message at his or her computer and addresses it to the address believed to be correct for an intended recipient" (col. 9, lines 4-6) and then sends the message. This feature thus teaches sensing the subsequent email address before sending it – by accepting the address of the message to be sent, the computer "senses" the address prior to sending it. Thus, both the claimed feature and the feature argued by applicant is taught by Tsuei.

In considering (c), Applicant contends that Tsuei does not teach that the historical database is "in communication with the first system via a communication network," as recited by claim 1. Examiner respectfully disagrees. Applicant's own argument in fact describes that Tsuei explicitly *teaches* such a feature. Applicant admitted that "Tsuei teaches an email address management system (EAMS) 330 that is connected directly to the internet 130 (see Figure 3)" (See p. 7, lines 6-7 of Applicant's argument). Thus, as shown in Figure 3 of Tsuei, the database 340 is in communication with the first system 112 via the Internet, which is by all means a communication network. Therefore, this claimed feature is taught by Tsuei.

In considering (d), Applicant contends that Tsuei does not teach or suggest each and every element as recited in claim 4, and therefore does not provide motivation for requesting authorization to determine if the subsequent address is the old email address of the first client. Examiner agrees that Tsuei does not teach or suggest each

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and every element as recited in claim 4, and has thus issued new grounds for rejection. Notably, the combination of Tsuei and Sommerer discloses all of the limitations of the claim, and motivation to combine the limitations comes from the general knowledge in the art that email senders may only want to send emails to certain addresses, and therefore should be able to actively elect to do so before messages they send are redirected.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bradley Edelman

BE

May 11, 2005